

**REMARKS**

In the Final Office Action, the Examiner rejected claims 106 and 107 under 35 U.S.C. § 101; rejected claims 1-14, 52-65, 103, 106, 109, 112, 115, 118, 123-125, and 127 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,546,005 to Berkley et al. ("Berkley") in view of U.S. Patent Application Publication No. 2002/0085701 of Parsons et al. ("Parsons"); rejected claims 17-24, 33, 34, 36-39, 68-75, 84, 85, 87-90, 104, 107, 110, 113, 116, 119, 126, and 128 under 35 U.S.C. § 103(a) as being unpatentable over Berkley in view of U.S. Patent No. 6,564,261 to Gudjonsson et al. ("Gudjonsson"); and rejected claims 25-31, 76-82, 117, and 120-122 under 35 U.S.C. § 103(a) as being unpatentable over Berkley in view of Gudjonsson and further in view of U.S. Patent No. 6,535,596 to Frey et al. ("Frey").<sup>1</sup>

By this Reply, Applicants have amended 1, 8, 17, 33, 52, 59, 68, 84, 103, 104, 106, 107, 109, 110, 112, 113, 123, and 124. Support for the amendments can be found in the specification, for example, at page 36, lines 4-13; page 37, lines 10-18; page 40, lines 9-18; page 43, lines 5-15; FIGS. 3, 6A, 6B, and 7. Claims 15, 16, 32, 35, 40-51, 66, 67, 83, 86, 91-102, 105, 108, 111, 114, and 129 were previously canceled without prejudice or disclaimer. Claims 1-14, 17-31, 33, 34, 36-39, 52-65, 68-82, 84, 85, 87-90, 103, 104, 106, 107, 109, 110, 112, 113, and 115-128 are pending, with claims 1, 17, 52, 68, 103, 104, 106, 107, 109, 110, 112, and 113 being independent. Based on the

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to the rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

**I. The § 101 Rejection of Claims 106 and 107**

The Examiner rejected claims 106 and 107 allegedly because “the claimed invention is directed to non-statutory subject matter.” Office Action at 2. The Examiner asserted that “[a]ccording to the broadest reasonable interpretation of the claims and in light of the specification, the ‘computer readable medium’ disclosed in claims 106 and 107 can be construed to include both transitory and non-transitory embodiments . . . .” Office Action at 2-3. The Examiner suggested that “[t]o comply with 35 U.S.C. 101, applicant . . . amend the claim to narrow the claims to cover only statutory embodiments by adding the limitation -- non-transitory -- to the claim, i.e. a non-transitory computer readable medium.” Office Action at 3. Although Applicants disagree, in order to advance prosecution, Applicants have amended claims 106 and 107 to recite “a non-transitory computer-readable medium,” as suggested by the Examiner. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 106 and 107.

**II. The § 103(a) Rejection of Claims 1-14, 52-65, 103, 106, 109, 112, 115, 118, 123-125, and 127 Based on Berkley and Parsons**

Applicants respectfully traverse the § 103(a) rejection of claims 1-14, 52-65, 103, 106, 109, 112, 115, 118, 123-125, and 127 over Berkley in view of Parsons because a *prima facie* case of obviousness has not been established with respect to claims 1-14, 52-65, 103, 106, 109, 112, 115, 118, 123-125, and 127.

Amended independent claim 1 recites, among other things, that “the preferred device is overridden when the retrieved data reflects selection of an override mode.” Berkley and Parsons, taken alone or in combination, fail to teach or suggest at least the recited elements.

With respect to claims 8, 9, 59, and 60, the Examiner asserted that Berkley discloses “routing the communication to the preferred to the voice mail based on a determination that the user is associated with a do not disturb mode (Berkley et al., col. 9 lines 63 - column 10 line 16).” Office Action at 6. This is incorrect.

The cited portion of Berkley discloses “establish[ing] preferences . . . depend[ing] on who is trying to reach the user.” Berkley, col. 9, line 63 - col. 10, line 4. Establishing preferences depending on who is trying to reach the user allows “another preference where the user would be disturbed by telephone far less often . . . if a salesperson or work colleague is calling.” Berkley, col. 10, lines 1-4. Thus, rather than teaching or suggesting “an override mode” and that “the preferred device is overridden when the retrieved data reflects selection of an override mode,” as recited in amended independent claim 1, Berkley merely discloses establishing different preferences for calls from different callers. See Berkley, col. 9, line 63 - col. 10, line 4. None of these preferences is an override mode because these preferences are simply conditioned on who is calling, and are not overridden when the retrieved data reflects selection of an override mode. For at least these reasons, Berkley does not teach or suggest that “the preferred device is overridden when the retrieved data reflects selection of an override mode,” as recited in amended independent claim 1.

Parsons does not teach or suggest that “the preferred device is overridden when the retrieved data reflects selection of an override mode,” as recited in amended independent claim 1, and the Office Action does not dispute otherwise as Parsons is relied upon only for its alleged teachings of “contact information for a calling party [being] sent to a user’s preferred device in the format of the preferred device when the data format required by the calling party and user’s preferred terminal are different.” Office Action at 4. Therefore, Parsons fails to cure the deficiencies of Berkley.

In view of the above-noted deficiencies of the Berkley and Parsons references, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 1. Also in view of those deficiencies, no combination of the applied references can possibly yield claim 1, nor could claim 1 have been predictable from the applied references. Further in view of those deficiencies, there would have been no motivation for one of ordinary skill in the art to modify the teachings of the references to achieve Applicants’ claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Amended independent claims 52, 103, 106, 109, and 112, although of different scope, recite elements that are similar those discussed above with respect to amended independent claim 1. For reasons similar to the reasons set forth above with respect to independent claim 1, a *prima facie* case of obviousness has not been established with

respect to claims 52, 103, 106, 109, and 112, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Dependent claims 2-14, 115, 123, and 125 depend from amended independent claim 1, and dependent claims 53-65, 118, 124, and 127 depend from amended independent claim 52. Because any claim that depends from a nonobvious claim is also nonobvious, Applicants request the withdrawal of the § 103 rejection of claims 2-14, 53-65, 115, 118, 123-125, and 127 at least by virtue of their dependence from claims 1 or 52.

In addition, the dependent claims recite further distinctions over the cited references. For example, amended claims 123 and 124 recite, among other things, “detecting at a switch in a voice network a communication from the calling party directed to the user at a calling number associated with the user.” The Examiner asserted that Berkley discloses “dialing a telephone number corresponding to the AUR system.” Office Action at 7. As correctly observed the Examiner, Berkley discloses a calling party “dialing a telephone number corresponding to AUR system 170 (such as e.g., dialing 1-800-CALLATTI)]” and not a calling number associated with the user. Berkley, col. 10, lines 53-59. Therefore, Berkley does not teach or suggest “detecting at a switch in a voice network a communication from the calling party directed to the user at a calling number associated with the user,” as recited in claims 123 and 124.

Parsons does not cure the deficiencies of Berkley. Parsons does not teach or suggest “detecting at a switch in a voice network a communication from the calling party directed to the user at a calling number associated with the user,” as recited in

claims 123 and 124. Instead, in the system of Parsons, the call is forwarded to a user after a call is received by PBX 102 of Office 100. Parsons, Abstract.

For these additional reasons, the *prima facie* case of obviousness has not been established with respect to the dependent claims, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

**III. The § 103(a) Rejection of Claims 7-24, 33, 34, 36-39, 68-75, 84, 85, 87-90, 104, 107, 110, 113, 116, 119, 126, and 128 Based on Berkley and Gudjonsson**

Applicants respectfully traverse the § 103(a) rejection of claims 17-24, 33, 34, 36-39, 68-75, 84, 85, 87-90, 104, 107, 110, 113, 116, 119, 126, and 128 over Berkley in view of Gudjonsson because a *prima facie* case of obviousness has not been established with respect to claims 17-24, 33, 34, 36-39, 68-75, 84, 85, 87-90, 104, 107, 110, 113, 116, 119, 126, and 128.

Amended independent claim 17 recites, among other things, that “the preferred device is overridden when the retrieved data reflects selection of an override mode.” As explained above with respect to claim 1, Berkley does not teach or suggest at least the recited elements of amended independent claim 17.

Gudjonsson does not teach or suggest the recited elements of amended independent claim 17, and the Office Action does not dispute otherwise as Gudjonsson is relied upon only for its alleged teachings of “information [being] sent to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device requires a different data format that the device used by the calling party to initiate the communication.” Office Action at 8-9. Therefore, Gudjonsson fails to cure the deficiencies of Berkley.

For at least the above reasons, the Office Action has failed to clearly articulate a reason why amended independent claim 17 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claim 17, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Amended independent claims 68, 104, 107, 110, and 113, although of different scope, recite elements that are similar those discussed above with respect to amended independent claim 17. For reasons similar to the reasons set forth above with respect to independent claim 1, a *prima facie* case of obviousness has not been established with respect to claims 68, 104, 107, 110, and 113, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Dependent claims 18-24, 33, 34, 36-39, 116, and 126 depend from amended independent claim 17, and dependent claims 69-75, 84, 85, 87-90, 119, and 128 depend from amended independent claim 68. Because any claim that depends from a nonobvious claim is also nonobvious, Applicants request the withdrawal of the § 103 rejection of claims 18-24, 33, 34, 36-39, 69-75, 84, 85, 87-90, 116, 119, 126, and 128 at least by virtue of their dependence from claims 17 or 68, as well as by virtue of their recitation of additional elements not taught or suggested by the cited references.

**IV. The § 103(a) Rejection of Claims 25-31, 76-82, 117, and 120-122 Based on Berkley, Gudjonsson, and Frey**

Dependent claims 25-31, 117, and 121 depend from amended independent claim 17, and dependent claims 76-82, 120, and 122 depend from amended independent claim 68. As explained above, Berkley does not teach or suggest that “the

preferred device is overridden when the retrieved data reflects selection of an override mode,” as recited in amended independent claim 17 and similarly in amended independent claim 68, and Gudjonsson fails to cure the deficiencies of Berkley.

Frey does not teach or suggest that “the preferred device is overridden when the retrieved data reflects selection of an override mode,” as recited in amended independent claim 17, and the Office Action does not dispute otherwise as Frey is relied upon only for its alleged teachings that “data corresponding to the calling party is retrieved from a database and preferences for the calling party are determined.” Office Action at 11. Therefore, Frey fails to cure the deficiencies of Berkley and Gudjonsson.

For at least the above reasons, the Office Action has failed to clearly articulate a reason why claims 25-31, 76-82, 117, and 120-122 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 25-31, 76-82, 117, and 120-122, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

## **V. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.



Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 1, 2010

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